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Sven Kornfalt

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EXAMINER

O HERN, BRENT T

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

05/01/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/581,261

**Applicant(s)**

KORNFALT ET AL.

**Examiner**

BRENT T. OHERN

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claims***

1. Claims 1-20 are pending with claims 14-20 new.

## **WITHDRAWN REJECTIONS**

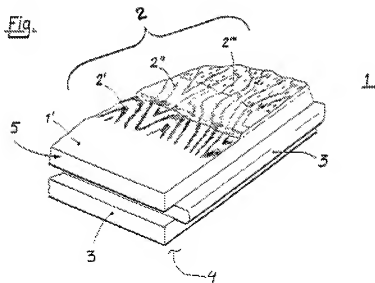
2. The 35 USC 102 rejections of claims 1-3, 7 and 11 as being anticipated by Martensson (US 6,397,547) of record in the Office Action mailed 6 November 2007, page 2, paragraph 1, have been withdrawn due to Applicant's amendments in the Paper filed 6 March 2008.
3. The 35 USC 102 rejections of claims 1, 4-6, 8-9 and 13 as being anticipated by Sjolin et al. (US 6,375,777) of record in the Office Action mailed 6 November 2007, page 3, paragraph 2, have been withdrawn due to Applicant's amendments in the Paper filed 6 March 2008.
4. The 35 USC 102 rejections of claims 1 and 10 as being anticipated by Sjoberg et al. (WO 02/47906) of record in the Office Action mailed 6 November 2007, page 4, paragraph 3, have been withdrawn due to Applicant's amendments in the Paper filed 6 March 2008.
5. The 35 USC 102 rejections of claims 1 and 12 as being anticipated by Pervan (US 2002/0007609) of record in the Office Action mailed 6 November 2007, page 4, paragraph 3, have been withdrawn due to Applicant's amendments in the Paper filed 6 March 2008.

## NEW REJECTIONS

### *Claim Rejections - 35 USC § 102*

6. Claims 1, 4-6, 8-9 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hansson et al. (US 6,465,046).

Hansson ('046) teaches a flooring system comprising a plurality of panels, at least one panel differing in aesthetic properties from another panel of the system, each carrying panel with edges (See FIG-1, col. 6, l. 65 to col. 7, l. 11 and col. 10, ll. 15-28 where a decorative surface element such as a map extends over several panels, thus providing for different aesthetic properties on the different panels since each panel has a different portion of the map.),



the edges being provided with means for joining (See FIG-1, entire FIG where the panel has tongues and grooves at the edges for joining the panels.), the carrying panel further being provided with an upper side and a lower side wherein the flooring system comprises a plurality of panels (See FIG-1, panels having upper/lower sides.) where

each panel is provided with an upper decorative surface and that the flooring system comprises panels with at least two of the decorative surfaces being a thermosetting composite comprising cellulose and a radiation curing melamine-formaldehyde amino resin with hard particles such as aluminium oxide, silicon oxide and silicon carbide, the particles having an average particles size in the range 50 nm-150  $\mu$ m (*See FIG-1 and col. 5, ll. 5-10, 39-54, decorative surface #2.*).

***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

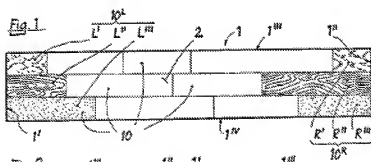
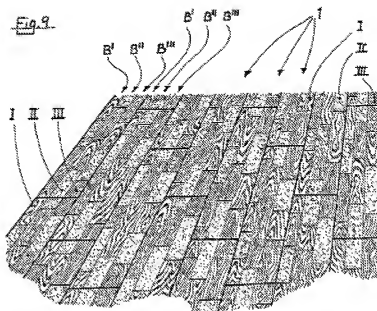
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 13 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sjöberg (US 2004/0170812).

Sjöberg ('812) teaches a flooring system comprising a plurality of panels with surface structures, at least one panel differing in aesthetic properties from another panel of the system, each carrying panel with edges (*See FIGs 9 and 1 where the panels with*

edges have different aesthetic appearances due to their surface structures I, II and III.

Some of panels as illustrated in FIG-9 have five surface structures on a side while other panels have 4 panels on a side, thus, different appearances.),



the carrying panel further being provided with an upper side and a lower side wherein the flooring system comprises a plurality of panels (*See FIGs 9 and 1 plurality of panels with upper and lower sides.*), where each panel is provided with an upper decorative surface and the flooring system comprises panels with at least two of the decorative surfaces being a thermosetting composite (*See para. 7 and FIGs 9 and 1.*) and

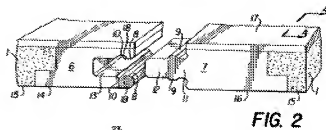
inherently teaches edges being provided with means for joining (*See FIGs 9 and 1 where the panels are joined by their edges having a means for joining.*),

In the alternative, a person having ordinary skill in the art would obviously appreciate or provide a means for joining the panels. Thus, a rejection under 35 USC 102/103 is proper (*See MPEP 2112.*).

**Claim Rejections - 35 USC § 103**

8. Claims 1-3, 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martensson (US 6,397,547) in view of Sjöberg (US 2004/0170812).

Regarding claim 1, Martensson ('547) teaches a flooring system comprising a carrying panel with edges (*See col. 3, ll. 31-42 and FIG-2, panel #1 with groove #6 and tongue #7.*), the edges being provided with means for joining (*See FIG-2, groove #10 and snapping web #9 for joining.*), the carrying panel further being provided with an upper side and a lower side wherein the flooring system comprises a plurality of panels (*See FIG-2, panels #1 and col. 2, ll. 30-63.*) where each panel is provided with an upper decorative surface and the flooring system comprises panels with at least two of the decorative surfaces being a thermoplastic composite or a thermoplastic foil, (*See col. 3, ll. 23-30 and FIG-2, #1.*).



however, fails to expressly disclose at least one panel differing in at least one of aesthetic or mechanical properties from another panel of said system.

However, Sjoberg ('812) teaches a flooring system comprising a plurality of panels with at least one panel differing aesthetically from another panel of the system (*See FIGs 9 and 1 where the panels with edges have different aesthetic appearances due to their surface structures I, II and III. Some of panels as illustrated in FIG-9 have five surface structures on a side while other panels have 4 panels on a side, thus, different appearances.*) for the purpose of providing panels with the desired décor or pattern (*See para. 3*).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide panels that differ aesthetically from another panel as taught by Sjoberg ('812) in Martensson ('547) in order to provide panels with the desired décor or pattern.

Regarding claim 2, Martensson ('547) teaches where the edges are provided with snap-joining functionality (*See FIG-2, groove #10 and snapping web #9*).

Regarding claim 3, Martensson ('547) teaches wherein the edges are provided with pre-applied glue (*See col. 2, ll. 43-47 and col. 4, ll. 6-11*).

Regarding claim 7, Martensson ('547) teaches wherein the thermoplastic composite comprises thermoplastic materials selected from the group consisting of polyvinyl chloride, and polyethylene (*See col. 3, ll. 23-27*).

Regarding claim 11, Martensson ('547) teaches where the thermoplastic foil is polyvinyl chloride, polyethylene or polypropylene (*See col. 3, ll. 23-27*).



9. Claims 1, 10 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoberg et al. (WO 02/47906) in view of Sjoberg (US 2004/0170812).

Regarding claim 1, Sjoberg ('906) teaches a flooring system comprising a carrying panel with edges (*See p. 1, ll. 16-25 floor laminate with edges.*), the edges being provided with means for joining (*See p. 1, ll. 16-25 wherein the panel clearly has edges and all edges can clearly be joined.*), the carrying panel further being provided with an upper side and a lower side wherein the flooring system comprises a plurality of panels (*See p. 1, ll. 16-25 wherein the plurality of panels have upper/lower sides.*), where each panel is provided with an upper decorative surface and the flooring system comprises panels with at least two of the decorative surfaces being a thermoplastic composite or a thermoplastic foil (*See p. 2, ll. 15-22.*), however, fails to expressly disclose at least one panel differing in at least one of aesthetic or mechanical properties from another panel of said system.

However, Sjoberg ('812) teaches a flooring system comprising a plurality of panels with at least one panel differing aesthetically from another panel of the system (*See FIGs 9 and 1 where the panels with edges have different aesthetic appearances due to their surface structures I, II and III. Some of panels as illustrated in FIG-9 have five surface structures on a side while other panels have 4 panels on a side, thus, different appearances.*) for the purpose of providing panels with the desired décor or pattern (*See para. 3*).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide panels that differ aesthetically

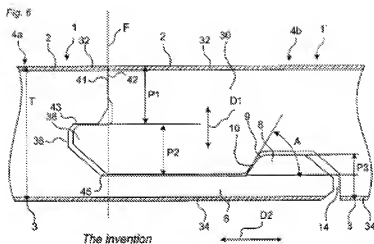
from another panel as taught by Sjoberg ('812) in Sjoberg ('906) in order to provide panels with the desired décor or pattern.

Regarding claims 10 and 14-16, Sjoberg ('906) teaches wherein the elastomeric foil comprises thermoplastic elastomers (*See p. 2, ll. 15-22.*).

The phrase "wherein the elastomeric foil is placed on panels wherein the panels are intended to be walkways while the rest of the floor has a high-gloss wood design of thermosetting composite" in claim 15, lines 2-3 is deemed to be a statement with regard to the **intended use** and is not further limiting in so far as the structure is concerned (*see MPEP 2111.02*). Sjoberg's ('906) panels are clearly capable of being used as such.

**10.** Claims 1 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pervan (US 2002/0007609) in view of Sjoberg (US 2004/0170812).

Regarding claim 1, Pervan ('609) teaches a flooring system comprising a carrying panel with edges (*See para. 62 and FIG-6, panels #1 and #1'*), the edges being provided with means for joining (*See para. 62 and FIG-6, wherein panels #1 and #1' are joined by tongues #38 and grooves #36.*), the carrying panel further being provided with an upper side and a lower side wherein the flooring system comprises a plurality of panels (*See para. 62 and FIG-6, panels #1 with upper/lower sides.*), where each panel is provided with an upper decorative surface and a metal sheet (*See paras. 9 and 62 and FIG-6, panels #1 and #1'*),



however, fails to expressly disclose at least one panel differing in at least one of aesthetic or mechanical properties from another panel of said system.

However, Sjöberg ('812) teaches a flooring system comprising a plurality of panels with at least one panel differing aesthetically from another panel of the system (See FIGs 9 and 1 where the panels with edges have different aesthetic appearances due to their surface structures I, II and III. Some of panels as illustrated in FIG-9 have five surface structures on a side while other panels have 4 panels on a side, thus, different appearances.) for the purpose of providing panels with the desired décor or pattern (See para. 3).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide panels that differ aesthetically from another panel as taught by Sjöberg ('812) in Pervan ('609) in order to provide panels with the desired décor or pattern.

Regarding claim 12, Pervan ('609) teaches wherein the metal sheet is aluminium foil (*See para. 9.*).

11. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sjöberg (US 2004/0170812) in view of Bettinger (US 3,811,237).

Regarding claim 17, Sjöberg ('812) teaches the system discussed above, however, fails to expressly disclose where the fabric comprises a needle loom carpet.

However, Bettinger ('237) teaches that floor panels made of carpet and other materials such as vinyl are known (*See col. 4, ll. 33-61 and FIGS 4A, 10 and 1, panels #20. Furthermore, a needle loom carpet and Bettinger ('237) carpet are interpreted as being interchangeable as Applicant has not presented any criticality of using one carpet over another.*) for the purpose of providing a flexible, resilient walking surface for an easily accessible, expandable flooring (*See col. 1, ll. 16-35.*). Furthermore, it was known at the time Applicant's invention was made that in office environments people have a preference for flooring surfaces that are carpeted in some regions and smooth in the immediate vicinity of the desk chair so as allow for easy movement of a desk chair, especially one that has rollers.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide floor panels with carpet as taught by Bettinger ('237) in Sjöberg ('812) in order to provide a flexible, resilient flooring that can easily be used in combination with other flooring materials.

Regarding claim 18, Sjöberg ('812) teaches where the floor comprises a thermosetting composite (*See para. 7 and FIGs 9 and 1.*).

**12.** Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sjöberg (US 2004/0170812) in view of Bettinger (US 3,811,237) and Martensson (US 6,397,547).

Sjöberg ('812) and Bettinger ('237) teach the system discussed above, however, fails to expressly disclose where the floor comprises a thermoplastic foil.

However, Martensson ('547) teaches a flooring comprising a thermoplastic foil (*See col. 3, ll. 23-27.*) for the purpose of providing a flooring that does not absorb water (*See col.3, ll. 28-30.*).

Therefore, it would have been obvious to provide a flooring made of thermoplastic foil as taught by Martensson ('547) in Sjöberg ('812) in order to provide a flooring that does not absorb water.

**13.** Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sjöberg (US 2004/0170812) in view of Bettinger (US 3,811,237) and Sjöberg et al. (WO 02/47906).

Sjöberg ('812) and Bettinger ('237) teach the system discussed above, however, fails to expressly disclose where the floor also comprises an elastomeric foil.

However, Sjöberg ('906) teaches where the floor also comprises an elastomeric foil (*See p. 2, ll. 15-22.*) for the purpose of providing a floor with decreased sound production, especially when people walk on the floor with heels (*See p. 1, ll. 1-2 an 8-13.*).

Therefore, it would have been obvious to a person having ordinary skill in the art to provide a flooring with an elastomeric foil as taught by Sjoberg ('906) in Sjoberg ('812) in order to provide quieter floors.

#### **ANSWERS TO APPLICANT'S ARGUMENTS**

**14.** In response to Applicant's arguments (*pp. 6-7 of Applicant's Paper filed 6 March 2008*) that the previously cited references do not teach at least two panels being different from each other as now presented in the amended claims, it is noted that said new limitations are not cited as being taught by the previously cited references. These new limitation are now cited as being taught by new references, thus, Applicant's arguments are moot.

**15.** Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRENT T. OHERN whose telephone number is (571)272-0496. The examiner can normally be reached on Monday, Tuesday and Thursday, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brent T O'Hern/  
Examiner, Art Unit 1794  
April 26, 2008

/Elizabeth M. Cole/  
Primary Examiner, Art Unit 1794